

**Remarks**

Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayakawa et al. (US 5,550,938). Claims 2-3 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayakawa et al. in view of Shih (US 6,504,626).

1. Rejection of claims 1, 4, and 5 under 35 U.S.C. 102(b):

Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayakawa et al. (US 5,550,938) for reasons of record, as recited on pages 3-4 of the above-indicated Office action (part of paper no.17).

**Response:**

Claims 1 and 6 have been amended to patentably distinguish from the Hayakawa and Shih patents. Claims 1 and 6 now contain the limitation, "the portable storage device not being a computer". This limitation is supported on page 5, lines 14-15 of the specification and in the drawings, and no new matter is added through this amendment. The amended claims 1 and 6 now distinguish from both Hayakawa and Shih.

Hayakawa teaches in col.3 lines 43-47 that the image scanner 1 can be inserted into a disc driver 22 of a personal computer 21. Although the disc driver 22 is not a computer, transmitting images from the image scanner 1 to the disc driver 22 requires the use of the personal computer 21 as a host. Therefore, claims 1 and 6 of the instant application distinguish from this teaching by requiring that the data transfer be performed without the need of a host for controlling image data transmission.

In addition Hayakawa also teaches in col.4, lines 1-5 that the image data can be transmitted from the image scanner 1 to the personal computer 21 or the word processor 23. The personal computer 21 is a computer, and is therefore excluded by the new limitation added to claims 1 and 6. Moreover, when connected to the image scanner 1, both the personal computer 21 and the word processor 23 are hosts which control data transfer from the image scanner 1. Therefore, the amended claims 1 and 6

patentably distinguish from both the personal computer 21 and the word processor 23 in that these claims require that the data transfer not need a host for controlling image data transmission.

5        **Shih** teaches in col.3 lines 10-26 that the electric device 64 connected to the scanner 40 is an internet server, a LAN server, a printer, a personal computer, or a fax machine. Claims 1 and 6 are patentably distinguished from the internet server, the LAN server, and the personal computer since these are all computers and the amended claims 1 and 6 require that the portable storage device is not a computer. The printer  
10 and the fax machine also do not read on the amended claims 1 and 6 because neither a printer nor a fax machine is a portable storage device.

Therefore, neither Hayakawa nor Shih teach a portable storage device that is not a computer receiving image data from a scanner without the need of a host device to  
15 control image data transmission. In light of this, the applicant submits that claims 1 and 6 are patentable over Hayakawa and Shih, either alone or in combination. Claim 4 is dependent on claim 1, and should be allowed if claim 1 is allowed. Claim 5 has been cancelled, and is no longer in need of consideration. Reconsideration of claims 1 and 4 is respectfully requested.

20

2. Rejection of claims 2-3 and 6-8 under 35 U.S.C. 103(a):

Claims 2-3 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayakawa et al. in view of Shih (US 6,504,626) for reasons of record, as recited on pages 4-7 of the above-indicated Office action (part of paper  
25 no.17).

**Response:**

As was stated above, claim 6 is patentably distinct from the Hayakawa and Shih references, either alone or in combination. Moreover, claims 2-3 and 7 are dependent  
30 on their respective base claims and should be allowed if the respective base claims are allowed. Claim 8 has been cancelled, and is no longer in need of consideration. Reconsideration of claims 2-3 and 6-7 is hereby requested.

3. Introduction to new claims 9-16:

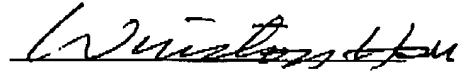
New claims 9-16 are written to further distinguish the present invention from both Hayakawa and Shih. Claims 9 and 13 state that the portable storage device is a standalone disk drive. Neither Hayakawa nor Shih teach this limitation. Although Hayakawa teaches in col.3 lines 43-47 transferring images to a disc driver 22 of a personal computer 21, this disc driver 22 is not a standalone disk drive, as is evident from both the specification and from Fig.4.

Furthermore, neither Hayakawa nor Shih teach that the standalone disk drive is a hard disk drive, a floppy disk drive, or a writable optical disk drive, as required by claims 10-12 and 14-16. These claims are supported by the specification on page 5, lines 14-15, and no new matter is added. Therefore, claims 9-16 are each patentably distinct from Hayakawa and Shih. Acceptance of new claims 9-16 is requested.

4. Introduction to new claims 17-21:

New claims 17-21 are written to claim a scanning system comprising a portable storage device which is not a computer and a scanner. As explained with respect to claim 1 above, neither Hayakawa nor Shih teach a scanning system in which image data is transferred from a scanner to a portable storage device that is not a computer without the need of a host to control the image data transmission. Claims 18-21 are duplicates of new claims 9-12, and no new matter is added through any of the new claims 17-21. Acceptance of new claims 17-21 is requested.

Respectfully submitted,



Date:

9/17/2004

5 Winston Hsu, Patent Agent No. 41,526

P.O. BOX 506

Merrifield, VA 22116

U.S.A.

Facsimile: 806-498-6673

10 e-mail : winstonhsu@naipo.com

(Please contact me by e-mail if you need a telephone communication and  
I will return your call promptly.)